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In re Application of :
SEMSCH, Angelika et al :
U.S. Application No.: 08/930,735 :
PCT No.: PCT/DE97/00187 :
Int. Filing Date: 26 January 1997 : DECISION
Priority Date: 27 January 1996 :
Attorney Docket No.: 0190 US/P :
For: DEVICE FOR PREVENTING OR :
REDUCING TIPPING OF THE HEAD :

This decision is in response to applicants' "Renewed Petition to Withdraw Holding of Abandonment" filed on 17 July 2002. No fee is required.

BACKGROUND

On 02 July 2002, a decision granting applicants' petition under 37 CFR 1.10(c) and dismissing applicants' petition to withdraw the holding of abandonment was mailed. The application became abandoned on 30 September 1997 for failure to pay the required basic national fee pursuant to 37 CFR 1.494(b)(2).

On 17 July 2002, applicants filed via facsimile the instant renewed petition.

DISCUSSION

In the renewed petition, applicants argue that the decision dated 02 July 2002 dismissing applicants' request to withdraw the holding of abandonment is incorrect and that the holding of abandonment should be withdrawn. Specifically, applicants claim:

- (1) 35 U.S.C. 371 allows the national fee to be paid at "such later time as may be fixed by the Commissioner." The Notification of Missing Requirements mailed 10 December 1997 set a new time limit and applicants met the time limit of this notice.
- (2) Applicants relied detrimentally on the statement in the Notification of Missing Requirements mailed 10 December 1997 and missed his opportunity to cure.
- (3) Counsel showed a clear intention to charge any required additional fees due in the above-captioned application by typing his Deposit Account number on the transmittal letter.

Moreover, counsel requests to reinstate the Notification of Missing Requirements mailed 10 December 1997 which was vacated by the decision dated 23 November 1998 because "it was vacated based on the incorrectly assigned filing date." Ren.Pet. at ¶ 13.

These arguments have all been considered *de novo* and again dismissed.

Concerning item (1), applicants submitted a check of \$520.00 with the national stage papers on 29 September 1997. The proper basic national fee was for the above-captioned application was \$910.00. 37 CFR 1.494 states, in part:

(b) To avoid abandonment of the application, the applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of 20 months from the priority date:

(2) The basic national fee (see § 1.492(a)). **The 20-month time limit may not be extended.**
(Emphasis added).

The Notification of Missing Requirements mailed 10 December 1997 had no effect on the status of the above-captioned application since it was already abandoned pursuant to 37 CFR 1.494(b)(2). The Notification of Missing Requirements did not set a new time limit to pay the required basic national fee allowed by 35 U.S.C. 371 since the application was abandoned prior to the mailing of the Notification by federal regulation.

With regard to item (2), applicants claim to have detrimentally relied upon the statement that the large entity fee would be charged to counsel's Deposit Account. Counsel claims that he could have filed a Bypass Continuation application under 35 U.S.C. 111(a) or as a national stage under 35 U.S.C. 371 along with a petition to revive under 37 CFR 1.137(b). Counsel claims that "it is solely through the action of the Office that counsel has been lulled into thinking that there was no problem until it was too late to take alternative action." Id. at ¶ 10.

Evidently, counsel believes that these are no longer viable options. This is incorrect. Counsel can pursue this application using a continuation application under 35 U.S.C. 111(a) or through a national stage case under 35 U.S.C. 371 by also filing a petition to revive pursuant to 37 CFR 1.137(b). The petition to revive for the continuation application would revive the international case for continuity only and then would be immediately abandoned. The petition to revive for the above-captioned case would also be appropriate since counsel has been actively pursuing a withdrawal of the holding of abandonment.

Regarding item (3), the box next to the authorization to charge any additional

fees to counsel's Deposit Account on the Form PTO-1390 was not checked even though the Deposit Account No. was listed. The USPTO has no authority to charge fees on a Deposit Account unless there is proper authorization in the application regardless of any alleged intention. Proper authorization is not granted unless the box is checked on the transmittal letter next to the statement that "[t]he Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 12-1099." See 37 CFR 1.25.

Finally, the decision dated 23 November 1998 also based the judgment on the fact that "the papers . . . did not include a Small Entity Statement or an authorization to charge additional fees, therefore, the application would be held abandoned even if it was timely filed." Accordingly, counsel is mistaken that the decision was solely based on the incorrectly assigned filing date which has been subsequently changed in the decision dated 02 July 2002. The filing of a small entity statement in an abandoned application has no effect on the lack of timely payment of the basic national fee.

DECISION

For the reasons above, applicants' renewed petition requesting that the holding of abandonment be withdrawn is again **DISMISSED** without prejudice.

Applicants should file a petition under 37 CFR 1.137(b) to revive the national stage application or file a new application under 35 U.S.C. 111(a) along with a petition to revive under 37 CFR 1.137(b). Failure to file such a petition will be construed as an intentional delay.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patent, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Affairs Division of the PCT Legal Office.



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